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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/878,581

**Applicant(s)**

NAKAGAWA, SUSUMU

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SEI/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/08/10 has been entered.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive.

On pages 20-21, applicant argues that Bar-el discloses that the object storage and personalization system are inside the server, and thus does not teach that the advertisement image providing apparatus transmits a selected advertising image by stream distribution via a network to the content providing apparatus.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Bar-el discloses where the advertising images are transmitted from the advertisement image providing apparatus (object storage) to the content providing apparatus (the video server personalization system).

Srinivasan discloses where the content providing apparatus and the advertisement image providing apparatus may be separate servers connected via the Internet (paragraph 203-206) and that the advertising images are transmitted from the advertisement image providing apparatus to the content providing apparatus (ad server pulls both the ads and the content and then transmits both to the viewer; paragraph 204).

Thus, it is the *combination* of Bar-el and Srinivasan which disclose the claim limitation.

In response to applicant's arguments on pages 20-21 regarding Bar-el and download/package distribution and restarting the stream, it is noted that Bar-el was never relied upon to disclose these limitations. As seen in the rejections, it is Srinivasan, and not Bar-el, which was relied upon for teaching those limitations.

On page 23, applicant argues that Srinivasan fails to disclose "package" distribution. In response, Srinivasan discloses multiple modes of distribution.

The video and ads can be combined at the video servers and transmitted to the receiver in real time (paragraph 204), the video can be transmitted in real-time with markers indicating where ads are to be inserted (paragraph 205-206). The receiver

would then request the ads from the ad server and insert them during playback (paragraph 205-206). Finally, the video content can be fully downloaded and stored prior to playback (paragraph 216). As the video is “packaged” for distribution with either targeted ads or URLs directing the receiver to stored ads, it clearly meets the broad claim limitation of “package” distribution.

On page 23, applicant argues that the Srinivasan discloses where the playback unit uses URL metadata to pull an ad, and does not disclose where the playback unit requests the ad server to provide the ads.

It response, it is noted that the use of the URLs to retrieve the ads involves the playback unit contacting the ad server and ‘requesting’ access to the content that is pointed at by the URL (paragraph 205-206). The server receives the request and then provides the content indicated by URL. This clearly meets the claim limitations, as the playback unit is not simply “pulling the ads” as applicant suggests, as it is communicating with the ad server so as to be provided the ads.

On page 23, applicant argues that the Srinivasan does not disclose that the playback unit provides an “advertisement insertion condition” to the ad server.

It response, the playback unit is indicating that the viewer has reached a point within the video content where an ad insertion is required by contacting the ad server to retrieve the ad (paragraph 205-206). This clearly constitutes an “advertisement insertion condition”.

In response to applicant's arguments that Srinivasan doesn't disclose transmitting an advertising image to the image content providing apparatus, Srinivasan explicitly discloses that the ad server will pull both the video and ads from other servers and then control the streams to start and stop them as needed to insert ads (paragraph 204). Thus, the ad server provides the content to the viewers and has the advertising images transmitted to it.

In response to applicant's arguments that Srinivasan doesn't disclose the content providing apparatus restarting the video stream, Srinivasan discloses starting and stopping the video stream as needed to insert ads (paragraph 204).

In response to applicant's further arguments on pages 24-27, see above.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 28, 29 and 30 recite a "program storage medium" which is directed to non-statutory subject matter as the broadest reasonable interpretation includes both

transitory and non-transitory forms. Language limiting the claims to a "non-transitory" form of storage medium would preclude the non-statutory embodiments, such as carrier waves and other transitory mediums.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-9, 19, 22, 30, 32, 33 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "said image content is transmitted via download distribution and package distribution" which is not supported by applicant's specification as originally filed. As described in applicant's specification at pages 45-55 and shown in Fig. 11, 13 and 14, download distribution and package distribution are alternative methods of delivering image content. There is no specific disclosure of the use of both methods together. Furthermore, there is no specific disclosure of the use of both methods so as to deliver the same image content.

Claim 19 recites "wherein said function of receiving the image content includes via package distribution and via download distribution" which is not supported by

applicant's specification as originally filed. As described in applicant's specification at pages 45-55 and shown in Fig. 11, 13 and 14, download distribution and package distribution are alternative methods of delivering image content. There is no specific disclosure of the system using of both methods together. Furthermore, there is no specific disclosure of the use of both methods so as to deliver the same image content.

Claim 22 recites "wherein acquisition of said image content via the network includes download distribution and package distribution" which is not supported by applicant's specification as originally filed. As described in applicant's specification at pages 45-55 and shown in Fig. 11, 13 and 14, download distribution and package distribution are alternative methods of delivering image content. There is no specific disclosure of the system using of both methods together. Furthermore, there is no specific disclosure of the use of both methods so as to deliver the same image content.

Claim 30 recites "wherein the acquisition including download distribution and package distribution" which is not supported by applicant's specification as originally filed. As described in applicant's specification at pages 45-55 and shown in Fig. 11, 13 and 14, download distribution and package distribution are alternative methods of delivering image content. There is no specific disclosure of the system using of both methods together. Furthermore, there is no specific disclosure of the use of both methods so as to deliver the same image content.

Claim 37 recites "providing the requested image content in its entirety to said image content reproducing apparatus includes (a) downloading via the network by stream distribution, the image content in its entirety to the image content reproducing



apparatus and (b) distributing the image content in its entirety to the image content apparatus via an information recording medium" which is not supported by applicant's specification as originally filed. While applicant's specification separately describes stream distribution and distribution via a recording medium as alternative distribution methods, there is no specific disclosure of the system using of both methods together. Furthermore, there is no specific disclosure of the use of both methods so as to deliver the same image content.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-16, 18, 20, 21, 28, 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-el (WO 99/26415 A1) (of record) in view of Srinivasan et al. (Srinivasan) (US 2001/0023436 A1) (of record) and Zigmond.

As to claim 10, Bar-el discloses an image content providing method of providing an image content via a network from an image content providing apparatus to an image content reproducing apparatus (page 7, lines 2-19), said image content providing method comprising the steps of:

requesting, via the stream distribution, distribution of said image content, said request sent from said image content reproducing apparatus to said image content providing apparatus (page 7, lines 20-22);

transmitting, via the network by one of stream distribution, download distribution and package distribution, said image content to said image content reproducing apparatus (Fig. 1; page 8, lines 4-18),

wherein, when said image content is transmitted via stream distribution, during transmission detecting the position of inserting the advertisement image in said image content at said image content providing apparatus (page 14, line 14-page 15, line 5);

requesting the advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5) and sending the advertisement inserting condition to the advertising image providing apparatus (page 14, line 14-page 15, line 5);

selecting said advertisement image to be inserted into said image content based on at least the advertisement inserting condition (page 11, line 14-page 14, line 21) and transmitting thereof said advertisement image selected by stream distribution to said image content providing apparatus at said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image content providing apparatus at the position of inserting said advertisement image in said image content at said image content providing apparatus (page 14, line 24-page 16, line 21);

distributing, via stream distribution the inserted advertisement image from said image content providing apparatus to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18).

While Bar-el discloses transmitting an advertising inserting condition to said image content reproducing apparatus (Fig. 6-7; page 17-18), detecting a position of inserting an advertisement image in said image content reproducing apparatus (Fig. 6-7; page 17-18), and selecting said advertisement image to be inserted into said image content based on at least an advertisement inserting condition (page 11, line 14-page 14, line 21), inserting said advertisement image transmitted to said image content producing apparatus at the position of inserting said advertisement image in said image content at said image reproducing apparatus (page 14, line 24-page 16, line 21 and page 17-18), and display thereof (Fig. 6-7), he fails to specifically disclose transmitting said image content via one of download distribution and package distribution, for both download distribution and package distribution, requesting an advertisement image providing apparatus, having said advertisement image, to distribute said advertisement image to said image content reproducing apparatus and sending said advertisement inserting condition to said advertisement image providing apparatus by said image content reproducing apparatus, transmitting said advertisement image selected by stream distribution via the network to said image content producing apparatus, selecting said advertisement image to be inserted based upon a maximum number of distribution times and for stream distribution, restarting stream distribution of said image content

from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will transmit the content via download distribution (paragraph 236) request an advertisement image providing apparatus, having said advertisement image, to distribute said advertisement image to said image content reproducing apparatus (paragraph 205-206), send said advertisement inserting condition to said advertisement image providing apparatus by said image content reproducing apparatus (paragraph 205-206), transmit said advertisement image selected by stream distribution via the network to said image content producing apparatus (paragraph 205-206) and for stream distribution, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes (paragraph 202-204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85) while providing the viewer with more options and flexibility on how to receive and view their desired content (paragraph 236).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include transmitting said image content via one of download distribution, for both download distribution and package distribution, requesting an advertisement image providing apparatus, having said advertisement image, to distribute said advertisement image to said image content reproducing apparatus and sending said advertisement inserting condition to said advertisement image providing apparatus by said image content reproducing apparatus, transmitting said advertisement image selected by stream distribution via the network to said image content producing apparatus, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream while providing the viewer with more options and flexibility on how to receive and view their desired content.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include selecting an advertisement based upon a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 18, while Bar-el discloses image content providing system (page 7, lines 2-19), comprising:

an image content providing apparatus having an image content and having a function of providing said image content via a network by stream distribution (Fig. 1; page 8, lines 4-18);

an advertisement image providing apparatus having an advertisement image to be inserted to said image content and having a function of providing said advertisement image via the network stream distribution to said image content providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5) based on at least an advertisement inserting condition (page 14, line 14-page 15, line 5);

an image content reproducing apparatus having a function of reproducing said image content and said advertisement image received from said image content providing apparatus (page 8, lines 15-18);

wherein said image content providing apparatus has a function of inserting the advertisement image transmitted via stream distribution from said advertisement image providing apparatus at the position in said image content (page 14, line 24-page 16, line 21) and providing via stream distribution said image content and said advertisement image to said image content reproducing apparatus (Fig. 1-2; page 7, line 11-page 8, line 18), he fails to specifically disclose restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the

user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 34, Bar-el, Srinivasan and Zigmond disclose wherein said image content is a moving picture (page 8, lines 11-18).

As to claim 36, while Bar-el discloses an image providing method of providing an image from an image program providing apparatus to an image program reproducing apparatus (page 7, lines 2-19), said image providing method comprising the steps of:

requesting, via the network by stream distribution, distribution of said image from said image program reproducing apparatus to said image content program providing apparatus (page 7, lines 20-22);

transmitting, via the network by stream distribution, said image to said image program reproducing apparatus (Fig. 1; page 8, lines 4-18) and during transmission detecting a position of inserting an advertisement image in said image at said image program providing apparatus (page 14, line 14-page 15, line 5);

requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image to said image program providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5) and providing advertisement inserting condition to said advertisement image providing apparatus (page 11, line 14-page 14, line 21);

selecting said advertisement image to be inserted into said image based on at least the advertisement inserting condition received (page 11, line 14-page 14) and transmitting thereof by stream distribution to said image program providing apparatus at



said advertisement image providing apparatus (page 12, lines 3-9 and page 14, line 22-page 15, line 5);

inserting said advertisement image transmitted to said image program providing apparatus at the position of inserting said advertisement image into said image (page 14, line 24-page 16, line 21); and

distributing, via the network by stream distribution, the advertisement image, wherein the image program providing apparatus instructs a plurality of deputy image program providing apparatuses to distribute the image with the inserted advertisement image to said program reproducing apparatus (plurality of intermediate routers and nodes present in an Internet distribution system; page 7, lines 13-19 and page 10, line 23-page 11, line 5), he fails to specifically disclose transmitting the selected advertisement via the network to said image program providing apparatus, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), insert advertisement images at the appropriate position (paragraphs 202-204) by transmitting the selected advertisement via network to the image program providing apparatus (video/ad servers are separate Internet servers; paragraph 204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of

providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include transmitting the selected advertisement via the network to said image program providing apparatus, restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 35, while Bar-el, Srinivasan and Zigmond disclose wherein said image content is video, they fail to specifically disclose wherein said video content is one of a movie, a drama and an animation.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide movies, dramas and an animation, which were all well known and popular forms of video, for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include wherein said video content is one of a movie, a drama and an animation for the typical benefit of providing viewers with the respective form of video content, such as a movie, drama or animation, that they desire, in an interactive video distribution system.

As to claim 20, while Bar-el discloses an image content providing apparatus for providing an image content via a network (Fig. 1; page 8, lines 4-18), said image content providing apparatus comprising:

an image content database for storing said image content (Fig. 2; page 11, lines 20-23);

image providing means having a function of receiving an advertisement image by stream distribution based on at least an advertisement inserting condition (page 12, lines 3-9 and page 14, line 22-page 15, line 5), inserting the advertisement image at a position in said image content of said image database (page 14, line 24-page 16, line

21) and distributing thereof via the network by stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18), and

list forming means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times and receiving the selected advertisement via the network at said image providing means.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), transmit the selected advertisement via network to the image program providing apparatus (video/ad servers are separate Internet servers; paragraph 204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of

providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include transmitting the selected advertisement via network to the image providing means, restarting distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the

typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 28, while Bar-el discloses a program storage medium stored with an image content providing program for providing an image content (Fig. 2; page 11, lines 20-23), said program storage medium comprising:

image providing means having a function of receiving an advertisement image via stream distribution based on at least an advertisement inserting condition (page 12, line 3-page 15, line 5), inserting the advertisement image at a position in said image content of said image database (page 14, line 24-page 16, line 21) and distributing of the advertisement image via a network by stream distribution (Fig. 1-2; page 7, line 11-page 8, line 18),

means having a function of forming information of viewing said image content stored to said image content database and providing said title list (means for user selection of an available video; page 11, lines 20-21), he fails to specifically disclose a title list, restarting stream distribution of said image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and a maximum number of distribution times and receiving the selected advertisement via the network at said image providing means.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for

the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), transmit the selected advertisement via network to the image program providing apparatus (video/ad servers are separate Internet servers; paragraph 204), insert advertisement images at the appropriate position (paragraphs 202-204) and then restart stream distribution of the video when the ad is finished (starting and stopping of ad and video streams; paragraph 204) for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream (paragraphs 198-202 and paragraph 44 and 85).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include restarting distribution of said

image content from said image content providing apparatus to said image content reproducing apparatus when the distribution of the advertisement image finishes and transmitting the selected advertisement via network to the image program providing apparatus, as taught in combination with Srinivasan, for the typical benefit of providing traditional advertisement slots for broadcast commercials within a requested video stream.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

As to claim 12, Bar-el, Srinivasan and Zigmond disclose wherein the position of said image content for inserting said advertisement image is detected at said image content reproducing apparatus based on advertisement inserting condition data having an advertisement image inserting position condition for designating the position of inserting said advertisement image and an advertisement image selecting condition for designating a category of said advertisement image capable of being inserted to said image content (column 14, lines 14-21 and column 11, lines 14-19).

As to claim 13, Bar-el, Srinivasan and Zigmond disclose wherein said advertisement inserting condition data includes an advertisement image reproducing



condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content (page 14, lines 14-21).

As to claim 14, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus (page 11, lines 9-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data (page 11, lines 9-19).

As to claim 15, Bar-el, Srinivasan and Zigmond disclose wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus (page 11, lines 6-19) and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said viewer information (page 11, lines 6-19).

As to claim 11, while Bar-el, Srinivasan and Zigmond disclose wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on information for

viewing said distributable image contents to be transmitted from said image content providing apparatus (page 7, line 20), they fail to specifically disclose a title list.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention to provide a title list, listing the available videos for selection, for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include a title list for the typical benefit of providing a well known user friendly means for viewers easily identify and select a desired video.

As to claim 16, Bar-el, Srinivasan and Zigmond disclose wherein said image content is provided by said image content providing apparatus by subjecting said image content to download distribution to said image content reproducing apparatus (see Srinivasan at paragraph 236).

As to claims 21 and 29, while Bar-el discloses an advertisement image providing apparatus having an advertisement image and providing said advertisement image (Fig. 2; page 11, lines 20-23), said advertisement image providing apparatus comprising:  
an advertisement image database for storing said advertisement image (page 11);

advertisement image selecting means for receiving by stream distribution selection information from an image content providing apparatus and via the Internet from an image reproducing apparatus (page 1, Fig. 1) and for selecting said advertisement image to be provided from said advertisement image database based upon said selection information (page 11 and 14);

advertisement image providing means having a function of providing by stream distribution said advertisement image selected by said advertisement image selecting means (Fig. 1-2; page 11 and 14) to the image content providing apparatus and the image reproduction apparatus (ads from object storage transmitted to the server for transmission to the viewers; Fig. 1-2 and 4) and generating an advertisement providing log which is history information when said advertisement image is selected (page 9, lines 10-18 and page 11, lines 14-19);

an advertisement providing log database for storing said advertisement providing log (page 9, lines 10-18 and page 11, lines 14-19); and

advertisement database registering means for attaching an advertisement identifier to said advertisement image and storing said advertisement image to said advertisement image database (page 12, lines 3-9), he fails to specifically disclose a maximum number of distribution times and receiving the advertisement selection via the Internet and transmitting the advertisement via the Internet.

In an analogous art, Srinivasan discloses a VOD system (paragraph 202) where a user will request a video (paragraph 202) and the system will stream the video to the user (paragraphs 202-204), transmit selection information to the advertisement server

via the Internet (paragraph 202-204), transmit the selected advertisement via the Internet to the image program providing apparatus (video/ad servers are separate Internet servers; paragraph 204) and insert advertisement images at the appropriate position (paragraphs 202-204) for the typical benefit of providing allowing multiple systems and servers to operate together to provide the video and advertising services (paragraphs 198-204).

Additionally, in an analogous art, Zigmond discloses a system for providing content and advertisements (column 4, lines 15-24) which utilizes advertisements which are provided to viewers up to a maximum number of times (column 13, lines 40-47) for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement (column 13, lines 45-47).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el's system to include receiving the advertisement selection via the Internet and transmitting the advertisement via the Internet, as taught in combination with Srinivasan, for the typical benefit of providing allowing multiple systems and servers to operate together to provide the video and advertising services.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el and Srinivasan's system to include a maximum number of distribution times, as taught in combination with Zigmond, for the typical benefit of preventing viewers from being frustrated through excessive exposure to the same advertisement.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-el, Srinivasan and Zigmond and further in view of Hite.

As to claim 17, while Bar-el, Srinivasan and Zigmond disclose transmitting and storing the image content to the image content reproducing apparatus prior to reproduction (see Srinivasan at paragraph 236), they fail to specifically disclose wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said image content reproducing apparatus.

In an analogous art, Hite discloses system for providing image content and advertisement images (column 7) where the content is provided by transmitting an information recording medium recorded with said content to said image content reproducing apparatus (column 9, lines 15-42) for the typical benefit of providing viewers with additional means to receive programming, which would reduce system bandwidth and could be provided during times that the transmission network is malfunctioning.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Bar-el, Srinivasan and Zigmond's system to include wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said image content reproducing apparatus, as taught in combination with Hite, for the typical benefit of providing viewers with additional means to receive programming, which would

reduce system bandwidth and could be provided during times that the transmission network is malfunctioning.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/  
Primary Examiner, Art Unit 2424

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